

REMARKS

In the Office Action dated November 23, 2003, the Examiner rejected Claim 10 under 35 U.S.C. § 112 for allegedly failing to particularly point out and distinctly claim the subject matter that the Applicant regards as his invention. The Examiner further rejected Claims 1, 9, 10, 16, and 28 under 35 U.S.C. 103(a) as allegedly being unpatentable over Petite et al., U.S. Patent No. 6,437,692, (“Petite et al.”), in view of Chou, U.S. Patent No. 6,327,533, (“Chou”). The Applicant respectfully traverses these rejection for the following reasons.

Claim Rejections – 35 U.S.C. § 112

The Examiner has specifically alleged that Claim 10 is directed to a sensing unit but that Claim 1, from which Claim 10 depends, refers to a system for processing information and not to a sensing unit. Claim 10 has been amended to recite a system for processing information. Therefore, the rejection is overcome and withdrawal thereof is respectfully requested.

Claim Rejections – 35 U.S.C. § 103

The Examiner has rejected Claims 1, 9, 16, and 28 under 35 U.S.C. §103(a) as being allegedly unpatentable over Petite et al. In view of Chou. The Applicant respectfully traverses the rejection for the reasons stated below.

To begin, it is a well-settled principle in the law that prior art is insufficient to form a basis for establishing unpatentability unless the art also contains some **teaching, suggestion, or incentive** to look to particular sources of information, to select particular elements, and to combine them to arrive at the claimed invention. *See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931 (Fed. Cir. 1990). If it even exists, that teaching, suggestion or incentive

must motivate the skilled artisan to combine the teachings or suggestions with a *reasonable expectation of success*.

Further, it is very important that that the teaching or suggestion to make the claimed combination and the reasonable expectation of success be apparent from the prior art, and not the Applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.03. It is therefore improper for the Examiner to use the Applicant's invention as a blueprint to hunt through the prior art for the claimed elements and then combine them as claimed. *See In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *see also Pentec, Inc. v Graphic Controls Corp.*, 776 F.2d 309, 314 (Fed. Cir. 1985) (Federal Circuit cautioning that in determining the appropriateness of applying a reference, "prior art may not be gathered with the claimed invention in mind.")

With that said, the Applicant respectfully submits that Petite et al. does not contain any teaching, suggestion, or incentive to look to Chou to select particular elements, and to combine them to arrive at the claimed invention with any reasonable expectation of success. With respect to independent Claims 1 and 28, the Examiner has alleged, among other things, that Petite et al. discloses the claimed system *wherein multiple data types and multiple server functions exist for a single customer corresponding to multiple services provided to said customers such that said data types and server functions are modifiable for different services*. Applicant respectfully submits that this is simply not the case.

The Examiner references Petite et al., column 11, line 33 – column 12, line 23 to support her allegation. However, nowhere in that passage, or in the entirety of the Petite et al. reference, appears any teaching of a system for processing information which is remotely accessible for computerized monitoring, management, and control of a condition the claimed system *wherein*

multiple data types and multiple server functions exist for a single customer corresponding to multiple services provided to said customers such that said data types and server functions are modifiable for different services. Indeed, most notably the Petite et al. does not describe the claimed multiple services. That is because Petite et al. is not at all directed to managing a customer's multiple services. Therefore, it is not surprising that Petite et al. contains no teaching (as the Examiner has conceded) with respect to multiple service providers. It follows then that since Petite does not disclose multiple services, Petite et al. does not and cannot disclose (1) the claimed multiple data types and multiple server functions for a single customer that correspond to multiple services; or (2) data types and server functions being modifiable for different services.

Because Petite et al. clearly does not teach the skilled artisan with respect to multiple services or different services, the skilled artisan would not have been motivated to look to Chou for a teaching with respect to multiple service providers. The Applicant respectfully submits that this clear disconnect between Petite et al. and Chou would serve to prevent the skilled artisan from arriving at the claimed invention, albeit with any reasonable expectation of success as required by law. Further, it is very important that that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be apparent from the prior art, and not the Applicant's disclosure. See *In re Vaeck*, 947 F.2d 488. The Applicant respectfully submits that motivation and suggestion to look to Chou for the skilled artisan are indeed lacking in Petite et al. The Examiner is respectfully reminded that "prior art may not be gathered with the claimed invention in mind", which the Applicant respectfully submits is the only way the Petite et al. and Chou could have been gathered. *Pentec, Inc. v Graphic Controls Corp.*, 776 F.2d 309, 314 (Fed. Cir. 1985).

Therefore, the Applicant respectfully submits that the Examiner has not made out a *prima facie* case of obviousness with respect of independent Claims 1 and 28, and Claims 9, 10, and 16 which depend on either Claim 1 or 28. Accordingly, the rejection should be withdrawn. Similarly, the rejection of dependent claims 13, 15, and 21 is overcome since these claims depend on either of the claims discussed above and those independents, the Applicant respectfully submits, are in condition for allowance.

Although the Applicant submits that the Examiner has not made out a *prima facie* case of obviousness, the Applicant has submitted evidence that would rebut a *prima facie* case of obviousness. In this regard, the Examiner is respectfully reminded that rebuttal evidence may include evidence of the “secondary considerations” of nonobviousness such as “commercial success” and the resolution of a “long felt but unresolved need”. See MPEP 2144.08. Rebuttal evidence can be in the form of attorney argument and a declaration under 37 CFR 1.132. See In re Soni, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

Attached as Exhibit 1 to this Amendment and Response is the Declaration of Thomas H. Witt (“Declaration”). As the Examiner will see, Mr. Witt has extensive experience in pest management and is qualified to speak on the long and unresolved needs in the pest management industry. Mr. Witt is the President of Witt Pest Management (“Witt”), Pittsburgh, Pennsylvania’s oldest pest management company. *See* Declaration, ¶ 1. Mr. Witt has worked in the industry for over forty (40) years and has been the head of Witt for approximately thirty (30) years. *See*, Declaration, ¶ 2. He is actively involved in various trade-related organization and has served in leadership positions of several trade-related organizations. *See* Declaration, ¶3.

As indicated above, rebuttal evidence may include evidence of the “secondary considerations” of nonobviousness such as “commercial success” and the resolution of a “long

felt but unresolved need". *See* MPEP 2144.08. According to Mr. Witt, the claimed system, otherwise referred to as EPM® or SecureChoice®, does indeed resolve a long felt but unresolved need. Furthermore, the claimed invention has achieved commercial success. *See* Declaration, ¶ 6-13.

With respect to identifying the long felt but unresolved need, Mr. Witt has declared that:

[t]here has existed in the industry a long and unresolved need for service providers, such as Witt, to efficiently communicate service-related information to the customer more effectively. For example, service providers have had a need to communicate to the customer what, if any, service was performed and the reasons precipitating such service. Prior to EPM®, it was conventional to communicate service-related information to a customer by way of a hand written note to the customer, or regrettably, to not communicate anything related to the service performed at all.

See Declaration, ¶ 6. Therefore, according to Mr. Witt, the long felt but unresolved need relates to effectively communicating service related information to customers.

An Article referenced by Mr. Witt further evidences this need. The article, dated October 1, 2003, appeared in PEST CONTROL MAGAZINE, ("the Article") and is attached to Mr. Witt's declaration as Exhibit A. The Article discusses another pest control company's (University Termite and Pest Control) experience with the claimed system. The Article quotes the president of University Termite and Pest Control. He describes the need to effectively communicate service-related information to the customer as follows:

[w]e've got a lot of people who **need** accountability for the service. They **need** to know that somebody has been there, that they've done something tangible, and that they've recorded it in such a way that everyone has access to it. Traditional reporting, such as logbooks or leaving paperwork on the doorstep, wasn't going to accomplish that because you have a lot of different personalities and schedules, including 'snowbirds' who only spend their winters in Arizona, returning back East during the hotter months of the year. So we **needed** a central depository to track what we've done, and we wanted the information to be verifiable in a way so the customers were happy that they were indeed getting what they were paying for. (emphasis added).

See Declaration, ¶ 7.

According to Mr. Witt and the Article, the claimed system resolved the long felt but unresolved need to effectively communicate service information to customers and is a drastic improvement over the prior methods of communicating service-related information to the customer. *See Declaration, ¶ 8.*

According to the Article, EPM® allowed University Termite and Pest Control to win both the termite contracts and general pest contracts of a 144-building homeowner's association with ease. Further, the Article states that the EMR®, while only accounting for 5% of University Termite and Pest Control's customers, accounted for 15% of the company's profits. This is clear evidence of the claimed invention's resolution of a long felt and unresolved need in the industry and the claimed system's commercial success.

See Declaration, ¶¶ 9-10.

Mr. Witt further attests to the claimed system's effectiveness and its resolution of a long felt and unresolved need. According to Mr. Witt, in the time period of October 2003 through December 2003 for example, the claimed system, EPM® increased Witt's technician's production per hour rate by 8%. This is because EPM® has, among other things, reduced the time it takes communicating service related information to the customer. *See Declaration, ¶ 11.*

Additionally, the claimed system has been responsible for reducing customer service requests by 16%. According to Mr. Witt, Customer service requests often occur when a customer is unaware that service has been performed or does not understand the service-related information that the service provider has provided. EPM® has better

informed customers of service related information. EPM® has also made service-related information more accessible to the customer and has presented the service-related information in a concise manner. Therefore, EPM® has directly contributed to the reduction of service requests, which in turn, positively affects the bottom line of Witt's business. *See Declaration, ¶12.*

The foregoing is clear evidence of the invention's commercial success and its resolution of a long felt but unresolved need. And it is notable that Mr. Witt is aware of no other service or product that has been able to achieve what EPM® has achieved in this regard. *See Declaration, ¶ 13.*

Therefore, the Applicant respectfully submits that the foregoing evidence of "secondary considerations" are sufficient to overcome the Examiner's rejection of Claims 1, 9, 13, 15, 16, 21, and 28, which is allegedly based on 35 U.S.C. 103(a) with respect to Claims 1, 9, 10, 16, and 28. Withdrawal thereof is therefore respectfully requested..

At this critical juncture in the case, the Applicant is of the opinion that a telephonic interview could serve to clarify any questions that the Examiner might have and would fairly serve to further the case. Therefore, the Applicant hereby requests an interview with the Examiner. The Applicant's attorney will contact the Examiner to schedule a time in the event that the Examiner grants the Applicant's request.

In any event, the Applicant respectfully submits that the application is in condition for allowance.

Respectfully submitted,

By


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